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11-21-03

Patent  
Attorney's Docket No. 018987-030

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of )  
)  
Nobuhiro MISHIMA ) Group Art Unit: 2623  
)  
Application No.: 09/756,924 ) Examiner: Jingee Wu  
)  
Filed: January 10, 2001 ) Confirmation No.: 6342  
)  
For: CODER, CODING METHOD, )  
PROGRAM, AND IMAGE )  
FORMING APPARATUS FOR )  
IMPROVING IMAGE DATA )  
COMPRESSION RATIO )

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Technology Center 2600

ELECTION

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Official Action dated October 20, 2003, Applicant hereby provisionally elects the species of Figures 3 and 4, with traverse. At least claims 1-7, 10, 24, and 26 read on the elected species.

However, Applicant submits that the election of species requirement is improper and must be withdrawn. Specifically, §802.02 of the MPEP defines restriction as a term that includes the practice of requiring an election between distinct inventions, and which includes an election of species requirement. In §803 of the MPEP, it is stated that under the statute, an application may properly be required to be restricted to one of two or more of claimed inventions only if they are able to support separate patents and they are either independent or distinct. It further states that if the search and examination of an entire application can be made without serious burden, the Examiner must examine on the merits, even though it includes claims to independent or distinct inventions. The section also states

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the restriction requirement in most cases.

In the election of species requirement set forth in the October 20, 2003 action, the Examiner has made the conclusory statement that the claims are directed to patentably distinct species. However, the Examiner has not provided any evidence or any explanation as to why the three alleged species are patentably distinct. Accordingly, the Examiner must provide the required evidence that the species are patentably distinct or else withdraw the requirement.

In addition, Applicant submits that an examination of all pending claims on the merits would not impose any serious burden on the Examiner. Specifically, each of the independent claims includes subject matter relating to a developing unit that develops the pieces of bit data on virtual planes and a coding unit that performs entropy coding on the developed bit data in the virtual planes.

Accordingly, Applicant submits that there would be no serious burden on the Examiner in examining all of the claims in the application.

Thus, in view of the foregoing arguments, the Examiner is respectfully requested to either withdraw the election of species requirement or restate the election requirement in accordance with U.S. Patent and Trademark Office regulations and guidelines.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: November 19, 2003

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